



UNITED STATES PATENT AND TRADEMARK OFFICE

M

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,488	08/03/2001	Edward C. Thayer	00-54	7287

7590 03/24/2004

Robyn Adams
ZymoGenetics, Inc.
1201 Eastlake Avenue East
Seattle, WA 98102

EXAMINER

NOLAN, PATRICK J

ART UNIT PAPER NUMBER

1644

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,488

Applicant(s)

THAYER ET AL.

Examiner

Patrick J. Nolan

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 11, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1644

1. Claims 1-5, 11 and 21-22 are pending.
2. Applicant's election of Group I, claims 1-5, 11 and 21 in the Paper received 12-31-03 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

It is noted that claim 21 was not withdrawn from the official claim set.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 4 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent application publication 2004/0033504 A1.

The '504 application teaches fragments of SEQ ID NO. 46, to be used in compositions with an acceptable carrier and as fusion proteins to be linked to the Fc region of an antibody, thereby meeting the limitations of the claims (see paragraphs 70, 74, 93 and 94 in particular). Attached is the sequence search which clearly indicates greater than 99% sequence identity of the prior art polypeptide with Applicant's claimed SEQ ID NO. 2. Since the '504 application

Art Unit: 1644

teaches fragments to be used in their compositions and fusion proteins, there are thousands of fragments of SEQ ID NO. 46 which are indetical to fragments of applicant's SEQ ID No. 2.

The claimed invention is anticipated by the prior art teachings.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is broader in scope than claim 1 from which it depends, since claim 4 only requires nine contiguous amino acids, while claim 1 is limited to a polypeptide of 520 amino acids. Correction is required.

7. As presently recited claims 1-3, 5 and 11 are allowable.

8. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

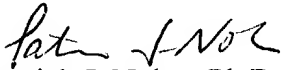
9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1644

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is 571-272-0847.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at 571-272-0841.

A handwritten signature in black ink, appearing to read "Pat J. Nolan", is positioned above the printed name.

Patrick J. Nolan, Ph.D.

Primary Examiner, Group 1640

March 22, 2004

Applicant's Copy

RESULT 4

US-10-258-951-46

; Sequence 46, Application US/10258951
; GENERAL INFORMATION:
; APPLICANT: Agarwal, Pankaj
; APPLICANT: Murdock, Paul R.
; APPLICANT: Rizvi, Safia K.
; APPLICANT: Smith, Randall F.
; APPLICANT: Xiang, Zhaoying
; APPLICANT: Kabnick, Karen
; APPLICANT: Lai, Ying-Ta
; APPLICANT: Xie, Qing
; TITLE OF INVENTION: NOVEL COMPOUNDS
; FILE REFERENCE: GP50025
; CURRENT APPLICATION NUMBER: US/10/258,951
; CURRENT FILING DATE: 2002-10-28
; PRIOR APPLICATION NUMBER: PCT/US01/13360
; PRIOR FILING DATE: 2001-04-26
; PRIOR APPLICATION NUMBER: 60/199,963
; PRIOR FILING DATE: 2000-04-27
; PRIOR APPLICATION NUMBER: 60/203,336
; PRIOR FILING DATE: 2000-05-11
; PRIOR APPLICATION NUMBER: 60/207,087
; PRIOR FILING DATE: 2000-05-25
; PRIOR APPLICATION NUMBER: 60/207,546
; PRIOR FILING DATE: 2000-05-26
; NUMBER OF SEQ ID NOS: 78
; SOFTWARE: FastSEQ for Windows Version 3.0
; SEQ ID NO 46
; LENGTH: 638
; TYPE: PRT
; ORGANISM: Homo sapiens
US-10-258-951-46

Query Match 99.3%; Score 3425.5; DB 28; Length 638;
Best Local Similarity 99.4%; Pred. No. 3.3e-295;
Matches 634; Conservative 0; Mismatches 1; Indels 3;
Gaps 1;

Qy 1 MAGGSATTWGYPVALLLLVATLGLGRWLQPD---
PGLRHSYDCGIKGMQLLVFPRPGQTL 57

|||||
|||||

Db 1
MAGGSATTWGYPVALLLLVATLGLGRWLQPD PGLPGLRHSYDCGIKGMQLLVFPRPGQTL 60

Qy 58
RFKVVDEFGNRFDVNNCSICYHWVTSRPQEPAVFSADYRGCHVLEKDGRFHLRVFMEAVL 117

|||||

Db 61
RFKVVDEFGNRFDVNNCSICYHWVTSRPQEPAVFSADYRGCHVLEKDGRFHLRVFMEAVL 120

Qy 118
PNGRVDVAQDATLICPKPDPSRTLDSQLAPPAMFSVSTPQTLSFLPTSGHTSQGSGHAFP 177

|||||
Db 121
PNGRVDVAQDATLICPKPDPSRTLDSQLAPPAMFSVSTPQTL SFLPTSGHTSQGSGHAFP 180

Qy 178
SPLDPGHSSVHPTPALPSPGPGPTLATLAQPHWGTEHWDVNKRDIYIGTHLSQEQCQVAS 237

|||||
Db 181
SPLDPGHSSVHPTPALPSPGPGPTLATLAQPHWGTEHWDVNKRDIYIGTHLSQEQCQVAS 240

Qy 238
GHLPCIVRRTSKEACQQAGCCYDNTREVPCYYGNTATVQCFRDGYFVLVVSQEMALTHRI 297

|||||
Db 241
GHLPCIVRRTSKEACQQAGCCYDNTREVPCYYGNTATVQCFRDGYFVLVVSQEMALTHRI 300

Qy 298
TLANIHLAYAPTSCSPTQHTAEFVVFYFPLTHCGTTMQVAGDQLIYENWLVSIGIHIQKGP 357

|||||
Db 301
TLANIHLAYAPTSCSPTQHTAEFVVFYFPLTHCGTTMQVAGDQLIYENWLVSIGIHIQKGP 360

Qy 358
QGSITRDSTFQLHVRCVFNASDFLPIQASIFPPSPAPMTQPGPLRLELRIAKDETCSSY 417

|||||
Db 361
QGSITRDSTFQLHVRCVFNASDFLPIQASIFPPSPAPMTQPGPLRLELRIAKDEFSSY 420

Qy 418
YGEDDYPIVRLLEPVEVRLQRTDPNLVLLHQCWGAPSANPFQPPQWPILSDGCPF 477

|||||
Db 421
YGEDDYPIVRLLEPVEVRLQRTDPNLVLLHQCWGAPSANPFQPPQWPILSDGCPF 480

Qy 478
KGDSYRTQMVALDGATPFQSHYQRFTVATFALLDSGSQRALRGLVYLCST SACHTSGLE 537

|||||
Db 481
KGDSYRTQMVALDGATPFQSHYQRFTVATFALLDSGSQRALRGLVYLCST SACHTSGLE 540

Qy 538
TCSTACSTGTTQRSSGHRNDTARPQDIVSSPGPVGFEDSYGQEPTLGPTDSNGNSSLR 597

|||||
Db 541
TCSTACSTGTTQRSSGHRNDTARPQDIVSSPGPVGFEDSYGQEPTLGPTDSNGNSSLR 600

Qy 598 PLLWAVLLLPAVALVLGFGVFVGLSQTWAQKLWESNRQ 635

Db 601 PLLWAVLLLPAVALVLGFGVFVGLSQTWAQKLWESNRQ 638